

Appl. No. 09/752,141

Attorney Ref: 5699-29

Response to Final Action of: June 8, 2004

REMARKS**1) Summary of the Office Action**

Claims 1 – 29 were pending in the application. Claims 19 – 27 were previously withdrawn from consideration as being non-elected. They are now cancelled to expedite prosecution of this case, with the applicant reserving the right to file a divisional case thereon. Claims 1 – 18 presently stand allowed. As in the Office Action of December 31, 2003, Claims 27 – 29 continue to stand rejected.

2) Rejection of Claims 27 – 29

Claims 27 – 29 have again been rejected under 35 USC 103(a) as being obvious given US Patent 5,757,566 of Stursberg ("Stursberg '566") in view of US Patent 4,516,614 of Grimhall et al. ("Grimhall '614") The applicant respectfully disagrees, and requests reconsideration of the present rejections.

As set out in MPEP 2142, *prima facie* basis for a rejection under 35 USC 103 requires a showing of the elements of a three part test. Those elements are (a) demonstration, in the objective evidence of record in the case of suggestion, motivation or incentive to combine or modify the reference or references in the manner proposed; (b) a demonstration that the resultant device would have a strong likelihood of success in arriving at the invention; and (c) a demonstration that the device so obtained would include all of the features of the claimed invention.

The Applicant respectfully submits that (i) there is no suggestion, motivation, or incentive to combine the references as proposed in the rejection; and (ii) that the device would not include the features of the invention.

The Applicant repeats, by reference, the previous commentary concerning the rejections mad on the basis of Stursberg in view of Grimhall.

The Applicant thanks the Examiner for the reply commentary of the Office Action of June 8, 2004, but respectfully submits that it does not provide grounds of support meeting the legal requirements to establish *prima facie* grounds for rejection of the claims. The motivation, suggestion, or incentive to combine must be found in the objective art of record in the case. In

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that regard, the Applicant draws the Examiner's attention to the following excerpts from *In re Lee*, 61 USPQ 2d 1430 (CAFC 2002), from which the citations have been omitted:

"As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section." The essential factual evidence on the issue of obviousness is set forth in *Graham v. John Deere Co.*, and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors).

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, ("teachings of references can be combined *only* if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*)

The need for specificity pervades this authority. *See, e.g., In re Kotzab*, ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination).

In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown

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authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

With the case of *In re Lee* in mind, the Applicant is somewhat surprised to find the commentary in the Office Action of June 8, 2004 that:

"Stursberg and Grimhall are both taught a conveyor for transfer cutting, therefore they are good to combine".

How does this statement meet the requirements of the law?

The Applicant respectfully submits that it does not. On the contrary, the Applicant respectfully submits that the foregoing quoted statement from the reply commentary in the Office Action of June 8, 2004 does not accurately reflect, or meet, the requirements of the law for establishing suggestion, motivation, or incentive to combine or modify.

The law requires that there be a thorough and searching inquiry into motivation to combine. The Office Action is required to explain why a person skilled in the art would combine the references. A mere statement that they "are both taught conveyors" sheds no light on why a person skilled in the art would, or would not, be motivated to modify or combine the references as proposed in the office action.

The Examiner is asked to review the requirements of the law on this point, and to reconsider whether the statements in the Office Action meet those requirements. In the event the rejection is upheld, the Examiner is explicitly requested under the Examiner's duty under MPEP 707.07 (g), to identify, and to provide a copy of, any case law or statutory provision forming a basis for the proposition that merely because references A and B both show feature X, therefore they are, for that reason alone, "good to combine". The Applicant expressly, and vigorously, denies that the law supports such a proposition.

A second conclusory statement is made in the office action as well "It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize in

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Stursberg a path defining a circuit about which said movable path can move as taught by Grimhall in order to run through or re-circulate the workpiece if needed.”

Where is the support in the objective evidence of record for this statement ?

A third statement in the Office Action also bears comment. The reply states:

“Further, Grimhall's reference is only cited for teaching a path defining a circuit about which said movable bed can move.” (Emphasis in original)

Implicit in this statement appears to be a proposition of law that references can be cited for showing this feature x, or that feature y, in isolation, without reading the document as a whole. That seems a doubtful proposition, for either of two reasons.

First, it has long been held that prior art references are to be read as a whole. As a matter of interpretation, the Applicant respectfully submits that the statement in the Office Action is unsupported by the law.

Second, to say a reference is “only” cited for this feature or that feature is a tell-tale of a hindsight rejection lacking an inquiry into motivation, suggestion, or incentive to combine. Hindsight rejections of this nature are not acceptable support for the rejection of claims, as indicated very plainly by *In re Lee*, as quoted above. See also: *Crown Operations International Ltd. v. Solutia Inc.* 62 USPQ 2d 1917 at 1922 (CAFC 2002):

“Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.” *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ 2d 1321, 1329 (Fed. Cir. 1998). There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. See *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ 2d 1161, 1167, (Fed. Cir. 2000); *ATD Corp.*, 159 F.3d at 546, 48 USPQ2d at 1329; *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ 2d 1377, 1379, (Fed. Cir. 1994) (“When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination.”).

See Also *Ruiz v. A.B. Chance Co.*, 69 USPQ 2d 1686 (CAFC 2004):

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In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. *Envtl. Designs, Ltd. v. Union Oil Co.*, (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result – often the very definition of invention.

Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole. This court has provided further assurance of an "as a whole" assessment of the invention under §103 by requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, the examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination. *See In re Rouffet*. (Citations omitted).

Therefore, the Applicant respectfully submits that both as an exercise in interpretation and as an exercise in hindsight analysis, the commentary in the Office Action demonstrates an approach that has been clearly rejected by the CAFC.

In addition, the features identified by the Examiner as Stursberg's bed consist of a set of rollers 16 that have a fixed location relative to the cutting head. How do we know they have a fixed location? Because Stursberg tells us, and shows us that they are. Stursberg tells us that the flat stock 10 is supported on rollers 16. The rollers 16 are mounted to the horizontal beams 14, which, in turn, are mounted to the vertical posts 12. Figure 1 shows us that post 12 is fixed to the ground. Even taking the Examiner's interpretation as correct (which the Applicant does not), how could Stursberg's bed, identified by the Examiner as item 8, go anywhere, let alone about Grimhall's path? Stursberg's "bed" does not go anywhere. How could there be motivation to combine these features as suggested in the Office Action? If combined, how could the two features yield the result proposed by the Office Action?

The Applicant respectfully submits that *prima facie* grounds for rejection of claim 27 under 35 USC, even before amendment, have not been established.

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3) Claim Amendments

Claim 27 has been amended to indicate that the "bed" is movable to another position distant from the cutting head.

Clearly, the rollers of Stursberg and the path of Grimhall are in fixed locations. If they are construed by the Examiner as being in a cutting position, then they cannot also be movable to a another position distant from the cutting head. Stursberg's rollers can move neither further away from, nor closer to, the cutting position.

With regard to claim 28, the Applicant also notes that the grounds for rejection do not establish that either Stursberg or Grimhall has a plurality of such beds.

4) Conclusion

The Applicant requests reconsideration of the rejections, and submits that all of the claims presently pending in the case are in a condition for allowance.

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CERTIFICATION

I hereby certify that, on the date shown below, this correspondence is being facsimile transmitted to the Patent and Trademark Office, (703) 872-9306.

Date: 8 September 2004
Signature

Michael H. Minns
(type or print name of person certifying)